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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HENDERSON, MARK T

ART UNIT

PAPER NUMBER

3722

DATE MAILED: 06/19/2003

21

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary

Application No.

09/322,594

Applicant(s)

PETKOVSSEK, GLENN

Examiner

Mark T Henderson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXING of responses to Office Actions directly into the Group at (703)305-3579. This practice may be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-15 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Petkovsek (5,697,648) in view of Schwan et al (5,524,934).

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Petkovsek discloses in Fig. 1, 2 and 6, a mailing assembly and a method for preparing a mailpiece comprising a backing sheet (11), first and second mailing forms (10a and 10b) removably attached to the backing sheet by an adhesive (Col. 6, lines 21-25) and separable by a tear line (60) wherein the forms includes a first return postcard (18) integrally formed with a designator section (20, 24A, and 26) indicative of a special service (Col. 4, lines 10-14 and 29-31) having an area consisting of a machine readable code (24 for tracking the mailpiece), an identifying number (26A), an area for receiving instructions (20), and being distinctly colored (Col. 4, lines 40-41) and contained within the first exterior sides (right of perforated line 29a, and left of perforated line 33a) that defines the postcard; wherein the first mailing form (10a) is removably attached (60) to the second mailing form (10b); wherein the second mailing form (Fig. 6) has a second return postcard (18b) integrally formed with a second designator section which is contained within the second exterior sides of the second return postcard; a first anchor portion (28) extending outside one of the exterior sides (33a) of the first return postcard, wherein the first anchor portion has adhesive (48) on the backside (Fig. 2), is removably attached to the postcard via a tear line (33) a removable label section (30) attached to the first anchor portion (28) via a tear line (32), a third designator section (36) contained within the first anchor portion, and a second anchor portion (27) removably attached to the return postcard by a tear line (29).

However, Petkovsek does not disclose: a designator section having a color corresponding to one of a plurality of special services, wherein the color is different for each one of the special services.

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Shwan et al discloses in Fig. 3, a record in the form of a label assembly (Col. 1, lines 10 and 11; and Col. 7, lines 14-16) having selected portions for forming areas of a plurality of different colors, wherein coating of colorless color formers and developers are initially combined (upon application of an imaging force) to form colored visible area (Fig. 3). The coatings (color formers and color developers) can be applied in selected areas on the label, and when combined can form blocks of background color(s) (Col. 4, lines 58-61) wherein the label can be used for mailing labels in which different colors are activated to designate the method (special services) of shipment.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by Schwan et al for the purpose of providing a means of emphasizing different categories of information on a label assembly.

In regards to **Claims 1, 7, 9 and 13**, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, Petkovsek's label is capable of denoting a special service that includes

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registered mail, certified mail, COD, return receipt for merchandise. Furthermore, in regards to Claim 13, the bar coded area of Petkovsek is capable of receiving instructions regarding the delivery of the mailpiece by a special service, since it would be obvious to program the bar code to receive or transmit any desirable information depending on the intended use of the bar coded area and the desired information to be retrieved.

In regards to **Claims 13-15**, the method for preparing a mailpiece for delivery by providing a backing sheet (Fig. 1), providing a first and second mailing form having a first and second return postcard integrally formed with a first and second designation section (as seen in Fig. 6), providing an anchor portion adjacent the return postcard (27 and 28 as seen in Fig 2), removing the mailing form from the backing sheet and attaching the form to a mailpiece (seen in Fig. 4), providing a removable label section (30) as a portion of the anchor portion (28, as seen in Fig. 1, and stated in Col. 5, lines 1-6), a providing an area for variable printed information (signature section (marked by an "X") shown in Fig. 5, below section (22)) is taught by Petkovsek.

2. Claims 16-20 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Walz (5,664,725) in view of Popat et al (6,001,209).

Walz discloses in Fig. 1, 4 and 5, an assembly comprising a first form (84) having a first postcard (70), a first anchor portion (58) removably attached to the postcard via a tear line (24), wherein the first anchor has adhesive (16) on the backside of the anchor (seen in Fig. 5), a first

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backing strip (49) received over the adhesive on the anchor portion's backside, an integrally formed designator section (73) indicative of special services such as restricted delivery which can consist of: certified mail, COD, insured mail, etc..(Col. 4, lines 45-48), an area (66) contained within the postcard printed with machine readable code (75), and a second form (82) removably attached to the first form by a tear line (20).

However, Walz does not disclose: a second form having a second postcard and a second anchor portion; and a first return postcard having no adhesive.

Popat et al discloses in Fig. 10, an assembly comprising a first form (254a) and a second form (254b), having anchor portions (258, 256, 256c) wherein a tear line (252c) is arranged to separate the first form from the second form.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Walz's assembly to include multiple form assembly connected by a tear line as taught by Popat et al for the purpose of printing multiple areas of a sheet without disposing extra unused paper area and for providing convenience for anyone using an advanced printer.

In regards to **Claim 16**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have any desirable indicia in the designator section since it would only depend on the intended use of the assembly and the desired information to be displayed. *In re Gulack* 217 USPQ 401, (CAFC 1983). The fact that the content of the printed matter placed in the designated section may render the section more convenient by providing an

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individual with a specific form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate that is required for patentability.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable amount of mailing forms with postcards and anchor portions, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Further, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the two substrate return postcard as a single substrate postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Response to Arguments

3. Applicant's arguments filed on November 25, 2002 have been fully considered but they are not persuasive.

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In response to applicant's arguments that the Petkovsek reference does not disclose a designator section having a color corresponding to one of a plurality of special services, wherein the color is different for each one of the special services. The examiner submits that the Petkovsek reference as modified by Schwan et al discloses this limitation. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Petkovsek's label to include a label having designated areas, wherein each area has a color corresponding to a shipment method (special services) as taught by Schwan et al for the purpose of providing a means of emphasizing different categories of information on a label assembly.

In response to applicant's argument that the Petkovsek and Walz references do not disclose a designator section within the exterior sides that define a postcard wherein the designator section is integrally formed with the return postcard, the examiner submits that both Petkovsek and Walz discloses a designator section in Fig. 1 as set forth in the above 103 rejections. Further, since applicant has not defined in detail what "special service" entails in Claim 16, the examiner has interpreted "special service" in its broadest sense. Furthermore, Applicant's arguments regarding "the special designation section" do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

In regards to Applicant's argument that the prior art of record does not teach a first and second return post card wherein the "return post cards do not have an adhesive backside", the

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examiner submits that Walz does indeed teach that the backside of the post card (78) does not have adhesive. The return postcard in the Walz reference is considered is disclosed as having two substrates divided by an adhesive (as seen in Fig. 1, (front) and 5 (back) and 3 (showing adhesive which divides the substrate). Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the two substrate return postcard as a single substrate postcard, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art.

Conclusion

4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however,

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will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (703)305-0189. The examiner can be reached on Monday - Friday from 7:30 AM to 3:45 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner supervisor, a. L. Wellington, can be reached on (703) 308-2159. The fax number for TC 3700 is (703)305-3579. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the TC 3700 receptionist whose telephone number is (703)308-1148.



MTH

June 9, 2003



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